REMARKS

Claims 1-13 are pending in the application. Claims 3, 7, 8 and 9 are currently amended. .

Claim 7 has been amended to recite an extension piece assembly, as shown in Fig. 7. The claim retains the previous limitations, but also positively recites the motorcycle and the trailer. Dependant claims 8 and 9 have been amended to make proper reference to "extension piece assembly."

Claim 7 stands rejected under 35 U.S.C §102(b) over United States Patent 5,016,897 issued to Kauffman, which shows a drop extension piece for use with a car dolly that is towed by a truck. The car dolly has side ramps that can be tilted to drop, as shown in Fig. 5, in order to drive the wheels of a vehicle onto the ramps. Claim 7 now distinguishes Kauffman by reciting the use of a motorcycle, which is nonanalogous art with respect to the Kauffman car dolly. A motorcycle cannot be practically used to tow a car, and so those skilled in the art of motorcycle-trailer design would not reasonably consult the car dolly art when seeking to adopt towing designs.

Claims 1, 2, 4-6 and 13 stand rejected under 35 U.S.C §103(a) as being unpatentable over Alvord, which does not show the claimed feature of "the cross-member touching the first line of downward extension and the second line of downward extension." The Office asserts that it would have been an obvious design choice to provide this feature, as the extensions serve no apparent purpose. We respectfully traverse.

The recited limitation is not a mere equivalent substitution or equal design choice. The primary objective of Alford is to make the hitch mechanism hidden from view, where the extensions do at least impart lateral stability upon torsion by potentially abutting the fender. Claim 1 provides the same lateral stability, but advantageously drops the receiver or ball hitch to a lower position, which drop may be supplemented to accommodate this genre of trailer by the extension piece of claim 7. Alford did not address this problem or acknowledge that this problem exists in the motorcycle towing art. Accordingly, Alford provides no suggestion that the problem may be overcome by a specific structural change as claimed.

It is also the case that Alford is not appropriate prior art. We attach an exact photostatic copy of Applicant's provisional application serial number 60/139,064 filed 6/11/99, which shows each and every limitation of claims 1-13. Priority to this provisional application was not claimed in the present case, which was filed on 8/11/00—more than one year after 6/11/99. A Rule 131 declaration could be filed to swear behind Alford's filing date of 10/25/99 because the 6/11/99 filing date of the '064 provisional has priority over Alford; however, some cases have held that abandonment of the provisional constitutes a corresponding abandonment of the constructive reduction to practice. Expiration of the '064 provisional in this case did not constitute abandonment because it was never Applicant's intent to abandon. The expiration occurred with Applicant's prior attorney, and appears to us to have resulted from an oversight or miscommunication. Without intent to abandon, there can be no actual abandonment.

We draw the Examiner's attention to *In re Costello and McClean*, 219 USPQ 389, 391 (Fed. Cir. 1983), which states:

> Rule 131, however, is only one way of overcoming a reference that is not a statutory bar. An applicant may also overcome a reference by showing that the relevant disclosure is a description of the applicant's own work. [8] The pertinent inquiry is under 35 U.S.C. §102(e). [9] Appellants can overcome a reference by showing that they were in possession of their invention prior to the effective date of the reference. "The real issue is whether all the evidence, including the references, truly shows knowledge by another prior to the time appellants made their invention or whether it shows the contrary." [citing *In re Land and Rogers*, 151 USPQ 621, 632 (CCPA 1966)].

The '064 provisional is sufficient to show knowledge by Applicant of the presently claimed invention prior to the filing date of Alford, and so antedates Alford which cannot be used as prior art. Therefore, the rejection of claims 1, 2, 4-6, 10 and 13 cannot be sustained by Alford.

Claims 1, 2, 4-6 and 10-13 are rejected under 35 U.S.C>§103(a) over Alford in view of United Stares Patent 5,853,187 issued to Maier. Alford is applied as above. Maier is used to show a ball hitch mounted on a tubular frame such that the side members meet precisely at the cross member. Maier constitutes nonanalogous art, as it describes a snowmobile hitch, not a motorcycle hitch. We fail to understand how the Maier hitch could be adapted for use in combination with Alford for any number of reasons. It seems that the tubular Maier hitch cannot be mounted for concealability beneath the motorcycle fender, and so use of the Maier hitch would defeat the primary purpose of Alford in providing a concealable hitch assembly. Therefore, there is no suggestion, rather, there is a teaching away. Besides, if Alford is removed

from consideration for the reasons indicated above, the combination of Maier and Alford also fails.

Claim 3 is rejected under 35 U.S.>C. §103(a) over Alford in view of United States Patent 6,-42,137 issued to McIntosh. Alford is applied as above. McIntosh is used to show a leveling means. The claimed means is shown in Fig. 6, which differs from McIntosh in that the means of Fig. 6 is fixed and not adjustable. It is rigid , whereas McIntosh shows an adjustable assembly. Claim 3 has been amended to recite this distinction, which is contrary to the purpose of McIntosh and avoids the problem therein suggested.

Based upon the foregoing discussion, we respectfully submit that claims 1-13 are allowable. Applicant's attorney believes that no additional fees are due, but the Commissioner is authorized to charge any additionally required fees to deposit account 12-0600. Applicant's attorney urges the Examiner to telephone if a conversation could expedite prosecution.

Respectfully Submitted,

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